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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,493	06/26/2003	Burton Kozak	0052/01006 CIP	5600

27197 7590 06/23/2005

CHERSKOV & FLAYNIK
THE CIVIC OPERA BUILDING
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CHICAGO, IL 60606

EXAMINER

SHAKERI, HADI

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,493

Applicant(s)

KOZAK, BURTON

Examiner

Hadi Shakeri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-15, 17, 18 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) 11, 14, 15, 17, 18, 21-23, 26 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10, 12, 13, 24, 25, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims 11, 14, 15, 17, 18, 21-23, 26 and 28 drawn to an invention nonelected with traverse in Paper No. 08/30/04. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "43" has been used to designate both "nut setter" and "magnetic tip" (as shown in Figs. 3A-3D). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

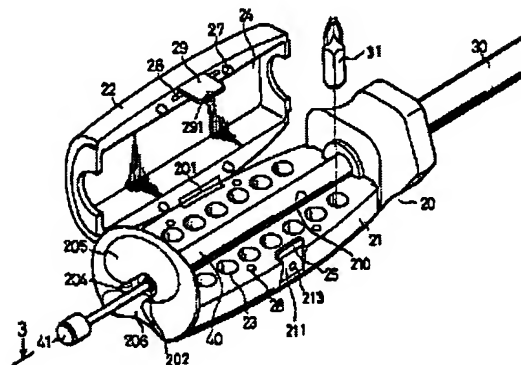
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1, 2, 4, 7, 10, 12, 13, 24, 25 and 28 (as best understood) are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Huang, US Patent No. 5,896,606.

Huang discloses all the limitations of claim 1, i.e. a combination driving and pick-up tool with a handle (20) a driving implement (21) and (30) and a pick-up implement (30) and (40) and means for



facilitating the deployment comprising a cap (41) magnetically attached to the member and in slidable communication with a periphery of the handle end.

Regarding claims 2, 4, 7, 10, 12, 13, 24, 25 and 28, Huang meet the limitations as best understood, e.g., cavities (23).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang.

Huang discloses all the limitations of claim 3, except for a power driven tool. However, modifying manually driven screwdrivers to make the tool power driven is considered to be the knowledge of one of ordinary skill in the art, so it may be driven automatically, and since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

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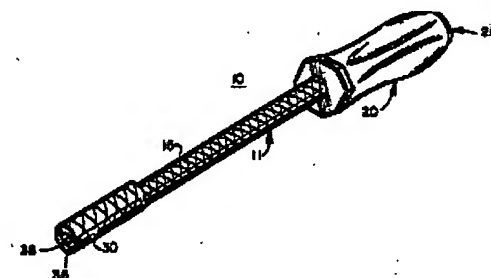
7. Claims 8 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang.

Huang discloses all the limitations of claim 7, except for non-circular cross-section.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use non-circular tubes for the pick-up tool, e.g., for static reasons, which would involve only routine skill in the art, since a telescoping "pick-up" tool would function just as well with circular or non-circular cross-section and since applicant has not disclosed that the specific cross section (for a non driving pick up member) solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with circular cross section.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang in view of Zurbuchen, US Patent No. 5,259,277.

Huang discloses all the limitations of claim 9, except for an electrically insulated tubes and/or cavities. Zurbuchen teaches an electrically insulated composite hand tool. It would have been obvious to



one of ordinary skill in the art, at the time the invention was made, to modify the tool of Huang with electrical insulation means as taught by Zurbuchen to adapt the tool so that it can be safely used in applications where it may come in contact with sources of electric power.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

10. Applicant's arguments filed 04/04/05 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a cap attached to a magnet) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The claims as recited, e.g., claim 1, recites, "means attached to the handle to facilitate deployment of said telescopic member from said second end, wherein said member deployment means comprises a cap magnetically attached to said handle, said telescopic member/cap combination providing a pick-up tool when said telescopic member is embedded in said handle".

The tool as disclosed by Huang, includes, means attached to the handle to facilitate deployment of said telescopic member (40) from said second end, wherein said member deployment means comprises a cap (41) magnetically attached to said handle, i.e., through (40)

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like the embodiment claimed in Fig. 3C, said telescopic member/cap combination providing a pick-up tool when said telescopic member is embedded in said handle"

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is (571) 272-4495. The examiner can normally be reached on Monday-Thursday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Hadi Shakeri', with a stylized flourish extending to the right.

Hadi Shakeri
Primary Examiner
Art Unit 3723
June 20, 2005